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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,875	02/16/2000	Toshikazu Nakajima	99USFP421-M.K.	5579

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EXAMINER

LEI, TSULEUN R

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 09/09/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

GA

**Office Action Summary**

Application No.

09/504,875

Applicant(s)

NAKAJIMA, TOSHIKAZU

Examiner

TSULEUN R. LEI

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23, 24, 28 and 29 is/are allowed.
- 6) ☒ Claim(s) 20, 21, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 22 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/27/03 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 20, 21, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Valimaa et al. (U.S. Patent 5,926,769).

Regarding Claim 20, Valimaa teaches a method of operating a portable telephone having plural numbered dialing keys that each have a unique identity for dialing a telephone number (Fig.2, keypad 22, it is inherent that each key on the keypad represents a number, which has a unique identity, for dialing a telephone number), the method comprising the steps of: establishing the telephone in a call origination mode; operating one of the plural numbered dialing keys and determining the unique identity of the operated one of the plural numbered dialing keys (Col.4, Lines 31-41, wherein a long depression of key number 5 recalls the telephone number stored at memory location 5); and changing from the call origination mode to an operating mode in which a call cannot be originated based solely on the determined unique identity of the operated one of the plural numbered dialing keys (Fig.3, Step B, wherein long key depression changes from dialing mode to read/write mode.).

Regarding Claim 21, Valimaa teaches the method of claim 20, wherein the operating mode in which a call cannot be originated is a stored telephone number search mode (Fig.3; Col.4, Lines 31-41, wherein the Read Mode is to recall a stored telephone number).

Regarding Claim 25, see Claim 20 for Valimaa's teaching.

Regarding Claim 26, see Claim 21 for Valimaa's teaching.

***Allowable Subject Matter***

4. Claims 23, 24, 28 and 29 are allowed.
5. Claims 22 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Amendment***

6. The amendment filed on 5/27/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Valimaa reference. The amendment does not overcome the prior art rejection of the use of time duration of key pressing to change the mode of operation, unless it is specifically excluded in the claim. Furthermore, the amendment of adding the word “unique identity” does not overcome the prior art rejection of Valimaa, because any key in the keypad can be broadly interpreted as having unique identity, unless it is specifically pointed out as that in Claim 23. Base on above reasoning, Claims 20, 21, 25 and 26 are rejected.

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***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TSULEUN R. LEI whose telephone number is 703-305-4828.

The examiner can normally be reached on 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 703-305-4379. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5403 for regular communications and 703-308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

TRL

September 3, 2003

*Marsha D Banks-Harold*

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